



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 10/813,934 | 03/31/2004 | Thomas P. Hager | 25424A | 5787 |
| 22889 | 7590 | 03/24/2006 | EXAMINER | |
| OWENS CORNING 2790 COLUMBUS ROAD GRANVILLE, OH 43023 | | | EGWIM, KELECHI CHIDI | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1713 | |
| DATE MAILED: 03/24/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---|-------------------------------------|--|
| Office Action Summary | Application No. 10/813,934 | Applicant(s) HAGER ET AL. | |
| | Examiner Dr. Kelechi C. Egwim | Art Unit 1713 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 134 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>070904 & 071105</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Both claims 10 and 30 recite the limitation "0 to about 20 percent by weight of said lubricant" in claims 8 and 28, respectively. There is insufficient antecedent basis for this limitation in these claims since both claims 8 and 28 require the lubricants yet claims 10 and 30, which depend there from, define the lubricants as not being required, as indicated by the 0 percent by weight embodiment.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 6-15 are rejected under 35 U.S.C. 102(b) as being anticipated by or Kono et al. (JP 04284236), Shiono et al. (JP 06289262), Kroesbergen (WO 96/23024),

Art Unit: 1713

Manning et al. (USPN 5,071,681), Gaa et al. (USPN 4,810,576) or Cossement et al. (USPN 5,236,982).

In the abstract, Kono et al. or Shiono et al. teach articles comprising coating layers on at least one surface, said coatings comprising a water-absorbent polymer and a binder.

Each of Kroesbergen (page 1, lines 1-17, page 2, lines 16-37, page 3, lines 14-22, page 4, lines 12-29 and the Example on page 9) and Manning et al. (col. 1, lines 6-28 and col. 2, lines 5-61) teach fibrous polymeric articles comprising, on at least one surface, a coating comprising a water-soluble superabsorbent polymer and a binder.

Each of Gaa et al. (col. 4, lines 50-55, col. 6, lines 5-60, col. 8, lines 12-14, col. 10, lines 5-7, and col. 11, lines 30-53) and Cossement et al. (col. 1, lines 44-51 and col. 5, lines 20-65,) teach fibers reinforcing material comprising coating/sizing compositions, said coating composition comprising an aqueous solution of a base neutralized polyacrylate, and polymeric/binder agents, along with any conventional compounds known to be useful in aqueous compositions for coating such fibrous substrate.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1713

7. Claim 2-5 and 16-34 are ejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Kono et al., Shiono et al., Kroesbergen, Manning et al. Gaa et al. or Cossement et al., above.

While the above prior art may not expressly teach the disclosed the properties of the claimed composition, it is reasonable that the prior art compositions would possess the claimed properties since the compositions are essentially the same as the claimed composition and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition or article is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al , 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

8. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arroyo et al. (USPN 4,913,517) or Geursen et al. (USPN 5,264,251) in combination with Barch et al. (USPN 4,466,151).

Each of Arroyo et al. (col. 3, line 1-15 and col. 4, lines 11-20) and Geursen et al. (col. 1, lines 7-10 and col. 3, lines 31-41) teach superabsorbent-coatings for fibrous

Art Unit: 1713

substrate, such as aramids, comprising a water-soluble polymer and other optional component such a viscosity modifying polymers.

Arroyo et al. or Geursen et al., differ from the claimed invention in that the coatings are not explicitly disclosed as comprising conventional components, such as binders. However, it is well known in the art to incorporate such components into a coating composition for fibrous substrate, for the purpose of facilitating the formation of a film on the substrate upon the drying of the coating composition, such as taught by Barch et al. (See col. 6, lines 18-20).

In col. 5, lines 61-66 and col. 6, lines 10-59, Barch et al. teach a coating for fibrous substrate, said coating prepared from a composition comprising the conventional coating components, such as an film forming binders (i.e., polyurethane.)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to incorporate components, such as binders, into the fiber coatings of Arroyo et al. or Geursen et al. in order to obtain the advantages taught by Barch et al., motivated by a reasonable expectation of success.

Further regarding the claimed advantages/improve properties, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would at least otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Art Unit: 1713

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER

KCE

A handwritten signature in black ink, consisting of a stylized 'K' followed by a cursive 'E' and a long horizontal stroke extending to the right.